

-11-

REMARKS

The Examiner has rejected Claims 1-13, 15, 17-29, 31, and 33-44 under 35 U.S.C. 103(a) as being unpatentable over Chen et al. (U.S. Patent No. 5,951,698) in view of Bates et al. (U.S. Patent No. 6,721,721) and in view of Perelson et al. (U.S. Patent No. 5,448,668). Applicant respectfully disagrees with such rejection, especially in view of the amendments made hereinabove to each of the independent claims. Specifically, applicant has incorporated the subject matter of dependent Claims 36-37 et al. into each of the independent claims.

With respect to each of the independent claims, the Examiner responded to applicant's last submitted arguments and amendments by presenting the following arguments:

'Column 5, lines 10-52 recite "a wide variety of application data files may be included in the memory such as word processing, spreadsheet, drawing programs, the memory may include Microsoft Word as Word processing, Excel as spreadsheet..." and further discloses (column 6, lines 10-67) .. examines targeted files to determine whether they are of a type that may include macro ... whether the targeted file is a template file - checking file extension such as .DOC. Therefore Chen et al clearly discloses files organized based on a type of application.'

"Bates et al discloses a database comprises set of indexes and macro virus status information with indexes associated with particular files (column 6, line 35 through column 7); files may also be organized according to type of application (column 8, line 65 through column 9; and column 12, line 15 through column 13, line 35)."

It appears that the Examiner is simply not considering the full weight and organization of applicant's claim language. Whether or not Chen/Bates discloses files organized based on application type, Chen/Bates does not organize "sets of the indices and the macro virus definition data files ... based on a type of application to which the macro applies" (emphasis added), as claimed. Further, it appears that the Examiner has simply not taken into consideration that applicant claims require organizing "sets of the indices and the macro virus definition data files ... into a hierarchy" (emphasis added), as

-12-

claimed. Only applicant teaches and claims a hierarchy of sets of indices and macro virus definition data, organized based on a type of application to which the macro applies.

The Examiner goes onto argues that Perelson et al discloses a hierarchical parse tree. Note below:

"Perelson et al discloses parsing a suspect file into tokens comprising one of individual string constants and source code text and storing the tokens as suspect strings into a hierarchical parse tree (Column 2, line 50 through column 42 and column 7, line 45 through column 9)."

However, after a careful review of such reference in its entirety, applicant asserts that Perelson make absolutely no mention of a hierarchical data structure, let alone organizing "sets of the indices and the macro virus definition data files ... into a hierarchy," (emphasis added) as claimed. Again, the Examiner's new proposed combination still fails to meet applicant's claimed hierarchy of sets of the indices and the macro virus definition data, organized based on a type of application to which the macro applies.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed.Cir.1991).

Applicant respectfully asserts that at least the third element of the *prima facie* case of obviousness has not been met, since the prior art references, when combined, fail to teach or suggest all of the claim limitations, as noted above. Nevertheless, despite

-13-

such paramount deficiencies and in the spirit of expediting the prosecution of the present application, applicant has substantially incorporated the subject matter of Claims 36-37 et al. into each of the independent claims.

In the latest action, the Examiner relies on the following blanket excerpts from Chen to make a prior art showing of the limitations of Claims 36-37. In particular, the Examiner cites col. 8, line 40 – col. 9, line 15; col. 12, lines 3-40; col. 13, line 20 – col. 14. However, after careful review of such excerpts, applicant respectfully asserts that the emphasized language below is clearly absent from such reference, contrary to the Examiner's assertion:

“wherein the macro virus definitions database stores at least one of string constants and source code text common to each macro virus family in the macro virus attributes for the macro virus definition data files; and the macro virus checker comparing the suspect string to the at least one of string constants and source code text in the one or more macro virus definition data files for each macro virus family;

wherein a parameter is utilized for specifying a threshold to matches of commonly shared at least one of string constants and source code text” (emphasis added).

Since at least the third element of the *prima facie* case of obviousness has not been met, a notice of allowance or a specific prior art showing of all of the claim limitations, in the context of the remaining elements, is respectfully requested.

Thus, all of the independent claims are deemed allowable. Moreover, the remaining dependent claims are further deemed allowable, in view of their dependence on such independent claims.

In the event a telephone conversation would expedite the prosecution of this application, the Examiner may reach the undersigned at (408) 505-5100. The

-14-

Commissioner is authorized to charge any additional fees or credit any overpayment to
Deposit Account No. 50-1351 (Order No. NAI1P373/99.111.01).

Respectfully submitted,
Zilka-Kotab, PC.

Kevin J. Zilka
Registration No. 41,429

P.O. Box 721120
San Jose, CA 95172-1120
408-505-5100